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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,394	07/03/2003	John Mcleido	J000-P0363US	5950
33356	7590	06/27/2006	EXAMINER	
SoCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362				BAUTISTA, XIOMARA L
ART UNIT		PAPER NUMBER		
2179				

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/614,394	MELIDEO, JOHN	
	Examiner	Art Unit	
	X. L. Bautista	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 April 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6, 11-17, 22-28 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6, 11-17, 22-28 and 33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see amendment, filed 4/6/06, with respect to the rejection(s) of claim(s) 1-6, 11-17, 22-28 and 33 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Yach et al and Giordano.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-6, 11-17, 22-28 and 33 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-27 of copending Application No. 10/840,889. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 2, 4-6, 11-13, 15-17, 22-24, 26-28 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by *Yach et al*(US 2002/0128036 A1).**

Claims 1 and 23:

Yach discloses a system and method for integrating voice and data operations into a single mobile device (abstract; p. 1, par. 0007) and displaying telephone numbers and other data. Yach teaches automatically scanning and identifying a data unit for identifying telephone numbers and other data; embedding (packaging) objects in the data unit (p. 5, par. 0050), the object allows for initiation of a telephone call using the identified telephone numbers (p. 6, par. 0054; p. 9, par. 0078-0082), the object defines a function for sending a data trigger to a switch to initiate a telephone call between telephones distinct from the client computer displaying the data unit (p. 5, par. 0048; p. 6, par. 0054-0059; p. 7, par. 0060). Yach teaches a dual mode mobile device having data and voice components, wherein the

data component is for establishing data communication channels with a computer over the data network and the voice component is for initiating and receiving telephone calls over a telephone network (initiating a phone call over a telephone network), (p. 1, par. 0008; p. 2, par. 0012). Yach teaches receiving a data item, identifying a phone number associated with the data item, and then initiating a telephone call to the associated phone number (initiating a phone call between a previously stored phone number and the identified telephone number), (p. 1, par. 0008-0011). Yach illustrates data units having a telephone number and/or electronic addresses having an associated telephone number, which are enhanced for easy recognition (figs. 4 and 6).

Claim 2:

See claim 1. Yach teaches recognition of contact information from emails and web pages. Yach explains that the method of displaying telephone numbers is performed as a consequence of an instruction to display the data unit (p. 1, par. 0011, 0012; p. 3, par. 0035; p. 9, par. 0087; p. 15, claim 1).

Claims 4, 15 and 26:

Yach teaches a data unit having displayable text intermixed with non-displayable data (p. 6, par. 0054); the user is enable to scroll through a message he/she is viewing, and the user is also enabled to access other information that is not being displayed by invoking a menu (p. 6, par. 0056).

Claims 5, 16 and 27:

See claim 1. Yach teaches detecting an activation instruction by the user of a displayed telephone number causing a telephone call to be initiated using the displayed number (p. 1, par. 0003, 0010; p. 6, par. 0054, 0057; p. 7, par. 0060).

Claims 6, 17 and 28:

Yach teaches a method that enables users to highlight and select a phone number by rolling over it (p. 9, pg. 0081).

Claims 11, 22 and 33:

See claim 1. Yach teaches that data units have embedded objects (hooks) for allowing initiation of telephone calls using an identified telephone number (p. 5, par. 0050; p. 6, par. 0054; p. 9, par. 0078-0082).

Claim 12:

See claim 1. Yach teaches a client computer having a user input device, a display device, a processor, and memory (p. 7, par. 0061).

Claims 13 and 24:

See claim 2. Yach teaches circuits and software for scanning the data unit as a consequence of an instruction to display the data unit (p. 9, par. 0084; p. 10, par. 0092; p. 11, par. 0094).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3, 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yach* and *Giordano, III* (US 6,870,828 B1).**

Claims 3, 14 and 25:

Yach teaches that data units can be an email message or a web page (p. 10, par. 0087). Yach does not teach data units are part of a file and that only a portion of the file is displayable. However, Giordano discloses a method of scanning data units (web documents), recognizing, displaying, and accessing telephone numbers appearing on the data unit (web page). The method has a parsing algorithm that recognizes telephone numbers and coding that is added to iconify the telephone numbers, the icons being selectable by a user to place a call (embedding objects to allow initiation of telephone calls). Giordano teaches that the telephone numbers are conspicuously rendered by including a button surrounding the number (attachments between displayed telephone numbers and telephone call initiation), font appearance, underlining, or highlighting (col. 2, lines 8-28; col. 3, lines 4-15, 37-

49, 57-65; col. 4, lines 20-27). Giordano teaches that the data unit (web page) is part of a file (col. 3, lines 25-32) and that only portions of the file may be displayed (col. 3, lines 33-43). Therefore, it would have been obvious to one ordinarily skilled in the art at the time of invention to modify Yach's method of displaying telephone numbers to include Giordano's teaching of displaying only portions of a file because users are provided only with the necessary information; this is especially convenient for those users having small portable devices having a small screen.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



X. L. Bautista
Primary Examiner
Art Unit 2179

xlb
June 21, 2006